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--22. (Amended) A method for paying an amount due indicated on a billing statement generated from an electronic database, comprising the steps of:

- receiving an acquisition offer to have at least a portion of said amount due paid by a third party in exchange for becoming a customer of said third party;
- indicating acceptance of said acquisition offer for said third party to pay at least a portion of said amount due; and
- becoming a customer of said third party.--

Add a new claim 27 as below:

AS

--27. (New) A computerized customer acquisition method comprising the steps of:

- selecting a customer account record from an electronic customer account database of a first entity, said customer account record including a customer identifier;
- determining if an individual indicated by said customer identifier is a customer of a second entity;
- providing an acquisition offer to said individual to pay an amount if said individual becomes a customer of said second entity;
- receiving acceptance of said acquisition offer from said individual; and
- acquiring the individual as a customer by transferring the amount to the first entity by the second entity.--

REMARKS

Claims 1-27 are now in this application, claim 27 having been added in this paper. Claims 1-26 stand rejected and are now presented for reconsideration in view of the foregoing amendments and the following remarks.

Claims 1-10, 12, 14-18, 20 and 22-26 were rejected under 35 U.S.C. sec. 101 as being "directed to non-statutory subject matter." To overcome this rejection and to advance this case to allowance, claims 1, 12, 14, 20 and 22 have been amended, in accordance with the

Examiner's suggestion, to indicate that the claimed subject matter is concerned with a computer-implemented invention. However, it is applicants' view that this rejection under section 101 is unwarranted, and applicants intend to pursue the claims as originally filed in a continuation application.

Claim 1-12, 14-20 and 22-26 were "rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps."

It is respectfully submitted that this rejection is misplaced for a number of reasons.

According to MPEP § 2172 (I), "[a] rejection based on the failure to satisfy this requirement [that the claim set forth the subject matter that the applicants regard as their invention] is appropriate only *where applicant has stated, somewhere other than in the application as filed*, that the invention is something different from what is defined by the claims." (emphasis added). Applicants have not so stated anywhere, much less in other than the application as filed. Otherwise "the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention." MPEP § 2172 (I). In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

Moreover, the Examiner erroneously proposes to require applicants to narrow the scope of their claims so as to cover only successful exercises of the customer acquisition method which is the subject of the invention. The two additional steps which the Examiner asserts are "essential" would, in fact, not be taken in the numerous cases in which one who practices the invention provides an "acquisition offer" that is not accepted by the prospective customer. Consequently, the claims do not either omit essential matter or fail to interrelate essential elements. Thus the present claims do not meet the circumstances set forth in MPEP sec. 2172.01 as grounds for a rejection under 35 U.S.C. sec. 112.

More specifically, and taking claim 1 as exemplary, the rejected claims recite "selecting a customer account record ... of a first entity [which includes] a customer identifier," "determining if an individual indicated by said customer identifier is a customer of a second entity," and "providing an acquisition offer to said individual."

The additional steps which the Examiner asserts are "essential" are recited in the present Office Action as: "receiving acceptance of the offer from the customer," and "acquiring the customer by transferring the offer amount to the first entity by the second entity." It should be apparent that these steps, far from being essential, are carried out only in the subset of cases in which the attempt to acquire a new customer is successful. Also, it is not seen how there is any "gap" between steps recited in claim 1 that is "filled" by the additional steps proposed by the Examiner. Rather, the steps proposed the Examiner logically follow the steps recited in claim 1, claim 1 being complete in itself as reciting all that is needed to present an "acquisition offer" to a prospective customer.

Furthermore, the Examiner has failed to indicate in what respect, other than alleged "incompleteness," the claims fail to satisfy the requirements of Section 112, second paragraph. As held by controlling case authority, Section 112, second paragraph, only requires that claims "set out and circumscribe a particular area with a reasonable degree of precision and particularity". In re Miller, 169 U.S.P.Q. 597, 599 (C.C.P.A. 1971); In re Moore, *supra* (reversing rejection of claims as allegedly "incomplete"). Since the rejected claims in this case meet this test -- the sole requirement of Section 112, second paragraph -- it is not seen how this rejection can stand. Applicants further submit that Section 112, second paragraph, does not authorize examiners to require inclusion of additional elements in claims.

It is therefore respectfully requested that the rejection under Section 112 be reconsidered and withdrawn.

* * * * *

Claims 1-26 were all rejected under 35 U.S.C. sec. 103(a). The rejection of these claims relied on a combination of the McNatt (Business Week) and Linnen (AT&T News Release) references, also taking into account, in some cases, teachings of the Jermyn patent no. 6,026,370.

Claim 1 is directed to a "computerized customer acquisition method," including steps of: "selecting a customer account record from an electronic customer account database of a first entity," where the customer account record includes "a customer identifier", "determining if an individual indicated" by the customer identifier "is a customer of second entity," and "providing an acquisition offer to said individual to pay an amount if" the individual becomes a customer of the second entity.

In determining the scope of the claim 1 (and other claims) it is important to take into account the following definition of the claim term "acquisition offer," as stated at page 6, lines 20-23 of the present application:

As used herein, an "acquisition offer" is an offer by the offeror service provider to pay an amount owed by the customer to the billing statement issuer as detailed in the billing statement, or a portion thereof, provided the customer agrees to become a customer of the offeror service provider.

It is explained at page 3, lines 17-26, of the present application that the customer acquisition system advantageously ties an acquisition offer into a billing statement because the target prospective customer is very likely actually to open and read a billing statement.

Applicants submit that errors in the claim rejections have arisen out of the Examiner's failure to note that the defined term "acquisition offer" specifies that the offer in question is to pay an amount owed to a third party. This feature -- imported into claim 1 and other claims by the term "acquisition offer" -- is not present in the prior art relied upon by the Examiner

It is believed that the McNatt and Linnen references, taken together, establish as prior art the practice in which an offeror service provider sends checks to prospective customers, whose endorsement of the checks results in the customers switching to the offeror's services. However, these references say nothing about offering to pay an amount owed to a third party as recited in claim 1 by inclusion of the defined term "acquisition offer." Since these references fail to disclose this feature, it is believed that claim 1 is patentable over the prior art cited by the Examiner.¹

The remarks just made in regard to claim 1 are equally applicable to claims 11-13, each of which also recites providing an "acquisition offer" to an individual.

Claim 14 is directed to a "computerized customer acquisition method" including steps of: "establishing in an electronic database predefined conditions for offering to pay an amount to an individual provided" the individual "becomes a customer of a first entity," and "providing" the predefined conditions "to a second entity to determine whether" the second entity "should provide an acquisition offer" to the individual.

As will be understood from the foregoing discussion of claim 1, the references cited by the Examiner disclose sending a check to a prospective customer but do not disclose providing conditions to an entity so that the entity may determine whether to offer to pay an amount the individual owes to a third party. This latter feature, inherent in claim 14 by virtue of the

¹ Applicant note that the Jermyn reference was not cited against claim 1 and, in any case, is equally silent with respect to the feature of offering to pay an amount due on a billing statement.

defined term "acquisition offer," serves to distinguish claim 14 from the references relied upon by the Examiner. Such is also the case with respect to claims 19-21.

Claim 22 is directed to a "method for paying an amount due indicated on a billing statement generated from an electronic database," including the following steps:
"receiving an acquisition offer to have at least a portion of" the amount due "paid by a third party in exchange for becoming a customer" of the third party, "indicating acceptance" of the acquisition offer for the third party to pay at least a portion of the amount due, and "becoming a customer" of the third party.

As noted before in connection with claim 1, the prior art relied upon by the Examiner has nothing to do with "paying an amount due indicated on a billing statement," nor with "indicating acceptance" of an "acquisition offer" that is defined as an offer to pay an amount owed to a third party. Accordingly, claim 22 is submitted as patentable over the prior art relied upon by the Examiner.

Each of the rejected claims not discussed hereinabove is dependent on one or another of the independent claims, and is submitted as patentable on the same basis as the respective parent independent claim.

* * * * *

New Claim 27 includes all of the features of claim 1 and is submitted as patentable on the same basis as claim 1.

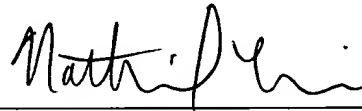
Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Nathaniel Levin at telephone number (203) 461-7114 or via electronic mail at nlevin@walkerdigital.com.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



May 10, 2000
Date

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